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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/501,540	02/09/2000	Michael D. Hitchcock	P-01800-US1	3996

25784 7590 02/24/2004

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EXAMINER

VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

7

Office Action Summary

Application No.

09/501,540

Applicant(s)

HITCHOCK ET AL.

Examiner

Gregory J. Vaughn

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Application History

1. This action is responsive to the applicant amendment, amendment filed on 12/16/2003.
2. Applicant has amended the specification in response to the objection cited by the examiner in the *Specification* section of the previous office action (dated 7/16/03). Applicant's amendment has addressed objections previously made and therefore, in view of this amendment, objections to the specification are withdrawn.
3. Claims 1-27 are pending in the case, claims 1, 12, 17 and 25 are independent claims. Claims 25-27 are added by amendment filed 12/16/2003.

Priority

4. Applicant's claim for domestic priority of US provisional application 60/119,496, filed 2/10/1999, under 35 U.S.C. 119(e) is acknowledged.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."

6. New claim 25, 26 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The new claim(s) contains subject matter, which was not described in the original specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new subject matter, which is not supported by the original disclosure is as follows: "*the printed form lacking identifying information encoded in machine-readable form*" (claim 25, first and third paragraphs), "*lacks encoded machine-readable identifying information*" (claim 26, first paragraph), and "*lacks machine-readable identifying information*" (claim 27, first paragraph).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."

8. Claims 17, 19 and 20 remain rejected under 35 U.S.C. 102(b) as being anticipated by Wang et al. US Patent 5,490,217 (filed 3/5/1993, patented 2/6/1996). "*Wang et al.*" is hereafter referred to as "*Wang*".

9. **In regard to independent claim 17**, Wang discloses a method of exchanging "documents and other forms of information" (column 1, lines 9 – 10) whereby Wang

establishes an equality between the terms "document" and "information". Wang discloses receiving information (described as "document") in electronic form over a network (column 3, lines 6-9). Wang discloses transmitting a request (described as "document") in printed form to a second source (described as "third party") (column 6, lines 59-61). Wang discloses receiving information in facsimile format (described as FAX) (see figures 1 and 2), where the information includes automatically interpretable identifying information (described as "machine readable image code") (column 2, lines 30-31). Wang discloses automatically interpreting the identifying information (described as "machine readable image code") to associate (described as "processing instructions") the information (described as "document") (column 2, lines 30-32). Wang further defines "processing instructions" as "relating documents to an identified entity" (column 2, line 7).

10. **In regard to dependent claim 19**, Wang discloses the identifying information as a bar code (column 1, line 58).
11. **In regard to dependent claim 20**, Wang discloses the identifying information as alphanumeric characters (column 1 lines 50-52).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject

matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

13. Independent claims 1 and 12 and dependent claims 6, 7, 8, 9, 10, 13, 15, 16, 22 and 24 remain rejected under 35 USC 103(a) as being unpatentable over Wang in view Tammaro US Patent Number US2001/0011246A1 (filed 8/10/98, published 8/2/2001) and in further view of Webster's II New College Dictionary (published in 1995).

14. **In regard to independent claim 1**, Wang discloses a method of transmitting and receiving a document (column 3 lines 1-7), over a network (column 4, line 1). Wang discloses "document", but fails to disclose "applications for admissions to institutions". However, Tammaro discloses a system transmitting an application to an institution (paragraph 26). Tammaro teaches that institution applications can be transmitted by a system.

Although, Wang discloses "transmitting" and "receiving", Wang fails to identify who the application is transmitted to and received from. However, Webster's definition of an "applicant" reads (page 55) "*One who applies, as for a job or admission.*" Webster's teaches that the intended user of an application is an "applicant".

Therefore, it would have been obvious to one of ordinary skill in the art, having Wang's automatic document handling system and the teachings of Tammaro and Webster's at the time the invention was made to modify Wang's automatic document

handling method to provide a method for the transmission and reception of electronic applications for institution.

Also, in regard to independent claim 1, Wang anticipates "automatically transmitting to a third party via facsimile a request for a document to be associated with the application." Wang discloses a facsimile transmitting device (described as "FAX") receiving instruction from a server (described as a "HOST COMPUTER") and transmitting to a second FAX device (see figure 1). Wang also discloses "a system for relating documents to an identified entity" (column 2, line 7), "instructions as to how the document is to be handled by the system" (column 3 lines 10-12) and transmitting through FAX to a third party (column 6, lines 59-61).

Wang also anticipates "receiving from the third party as facsimile data the document along with machine readable identifying information indicating the application to which the document is to be associated". Wang discloses "document with the resulting machine readable image code embedded will be transmitted through the same communication means back" (column 6, line 67 to column 7, lines 1-3) (compare receiving to transmitting back); where Wang's machine readable image code is used as in "a system for relating documents to an identified entity" (column 2, line 7).

Wang further anticipates "automatically determining from the facsimile data the identifying information and associating the facsimile data with the application, whereby the third party uses only a facsimile transmission device to transmit the document in electronic form and the machine readable identifying information

facilitates automatic matching of the document with the application at the institution.” Wang discloses an automatic interpreter (described as a “decoder”) (column 4, line 3) that associates a new document to an existing document (described as “machine readable image code which image code encodes identifying content”) (Column 2, line 30) “for relating documents to an identified entity” (column 2, line 7) by “fax communications” (see figures 1 and 2).

15. **In regard to independent claim 12**, Wang discloses an apparatus with a server, facsimile device and an encoder and decoder (embodied as a standard micro-computer) that interpret identifying information (see column 3, lines 65-67, and column 4 lines 1-4). Wang discloses the apparatus functioning as a server (described as “the system”) transmitting and receiving a document (column 2, line 61 through column 3, line 7), a server instructing a facsimile device to transmit a document (see figures 1 and 2), identifying information that instructs the server to associate the document to an existing entity (column 2, line 7 and column 3, lines 10-12). Wang discloses “document”, but fails to disclose “form”. However Tammaro discloses “form” (see figure 2). Tammaro teaches that a “form” can be transmitted and received.

Therefore, it would have been obvious to one of ordinary skill in the art, having Wang’s automatic document handling system and the teachings of Tammaro at the time the invention was made to modify Wang’s automatic document handling system to provide transmission, reception, encoding and decoding of forms for applicants, thereby providing a method of automatic document handling of forms.

16. **In regard to dependent claim 6**, Wang discloses a method for storing a file in facsimile format (described as "FAX") (see figure 3) and associating the file to an applicant (described as "relating documents to an identified entity") (column 2, line7).
17. **In regard to dependent claim 7**, Tammaro discloses verifying that the third party (described as "finance source") is participating in the transmission program (see figure 2, reference 112 and 116), and transmission by facsimile (page 1, paragraph 7).
18. **In regard to dependent claim 8**, Tammaro discloses verifying if the institution (described as "finance source") is participating in the transmission program (see figure 2, references 112 and 116).
19. **In regard to dependent claims 22**, Tammaro discloses a system that manages first information (described as "credit application") (page 1 paragraph 6) and second information (described as "department of motor vehicles forms") (page 1, paragraph 7), where the information is received and transmitted by a service provider (described as "credit application service provider") (page 1, paragraph 7), and transmitting the information to an end user (described as "user") (see figure 2).
20. **In regard to dependent claims 24**, Tammaro discloses determining if the second source (described as "department of motor vehicles") agrees to transmit via facsimile the second information (described as "department of motor vehicles forms") (page 1, paragraph 7).

21. **In regard to dependent claims 9, 10 and 13**, Wang discloses a method of transmitting documents (column 3, lines 2-3) and "all kinds of business transaction forms" (column 6, line 26).
22. **In regard to dependent claims 15 and 16**, Wang discloses an apparatus, which includes an interpreter (column 3, line 65-66) line that has the ability to encode/decode machine-readable image code (column 4, line 10-12) where the machine readable image code can be either bar codes or alphanumeric characters (column 1, lines 50 -58).
23. Dependent claims 2, 3, 4, 18, and 23 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Tammaro and Webster's and further in view of Schmid et al., U.S. Patent 5,659,164 (patented on 8/19/97).
24. **In regard to dependent claims 2, 18 and 23**, Wang and Tammaro fail to disclose the use of a cover sheet to contain the identifying information for the related document. Schmid discloses the use of cover sheet in column 3, line 37 as follows: "a cover sheet bearing machine-readable code markings containing identification of the document owner and desired routing ..."

Therefore, it would have been obvious to one of ordinary skill in the art, having Wang's automatic document handling system, Tammaro's auto credit application and the teaching of Schmid, at the time the invention was made, to add Schmid's facsimile cover sheet containing the identifying information to Wang's automatic

document handling system to achieve a system that can associate the document to an existing record in the system.

25. **In regard to dependent claims 3 and 4**, Wang discloses the identifying information in the form of a bar code or of alphanumeric characters (column 1, lines 50-59).
26. Claims 5 and 21 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Tammaro and Webster's, further in view of Mowry et al., U.S. Patent 5,853,197 (patented 12/29/98).
27. **In regard to dependent claims 5 and 21**, Wang discloses "document" but fails to disclose "transcripts". However, Mowry discloses "college transcript" at column 1 line 14.
- Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add "transcripts" to the inventions of Wang and Tammaro to provide a method for requesting and receiving transcripts by facsimile.
28. Dependent claims 11 and 14 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Tammaro and Webster's, further in view of MacPhail, U.S. Patent 5,089,956 (patented 2/18/92).
29. **In regard to dependent claims 11 and 14**, Wang and Tammaro fail to disclose transmission timing in the Automatic Document Handling System invention, but MacPhail discloses an "after" event timing of document transmission in column 3,

line 49. MacPhail discloses the following: "After the dialog manager application has gathered the above-identified information, it transmits the information ..."

Therefore, it would have been obvious to one of ordinary skill in the art, having Wang's automatic document handling system, Tammaro's auto credit application system and the teaching of MacPhail, at the time the invention was made, to incorporate event timing of transmission of documents into the automated document handling system to achieve a system that can manage associated documents where the documents are to be processed at different times.

Response to Amendment

30. The amendment filed 12/16/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "*the printed form lacking identifying information encoded in machine-readable form*" (page 6, claim 25, first and third paragraphs), "*lacks encoded machine-readable identifying information*" (page 7, claim 26, first paragraph), and "*lacks machine-readable identifying information*" (page 7, claim 27, first paragraph).

Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

31. Applicant's arguments filed 12/16/03 have been fully considered but they are not persuasive.
32. **Regarding claims 17, 19 and 20**, the applicant states "*Wang does not teach an embodiment that performs the steps of claim 17, 19 or 20*" (page 9, sixth paragraph). The applicant is directed to the rejection of claims 17, 19 and 20 as restated above. Applicant further states "*Applicant submits it is improper to pick and choose steps from different embodiments in a reference to support an anticipation rejection*" (page 9, last paragraph). The examiner acknowledges the fact that Wang describes multiple alternate embodiments, however the anticipation rejection was not derived from multiple embodiments. Elements of the anticipation rejection made under Wang were drawn from the "*Background Of The Invention*", "*Summary of the Invention*" and from one alternate embodiment entitled "*Electronic Notary*" of Wang. Applicant also states that Wang "*does not teach the specific interactions between the entity performing the claim steps and the two sources*" (page 10, first paragraph). Applicant is directed to the rejection of claims 17, 19 and 20 as restated above. In further support of the rejection Wang discloses in the "*Electronic Notary*" embodiment, (column 6, line 55 to column 7, line 16) a first source who desires an electronically notarized document, an entity (described as database on a network) that performs the claimed steps and a second source as an airline service, theater or stock service (column 7, lines 14-15).

33. **Regarding claims 1, 6-10, 12, 13, 15, 16 22 and 24**, the applicant states "as described above with respect to claims 17, 19 and 20, Wang teaches sending documents back and forth but does not teach the specific interaction between parties as claimed in independent claims 1 and 12" (page 10, fifth paragraph). Applicant is directed to the rejection of claims 1 and 12 as restated above, and is further directed to rejections of claim 17 as restated above and response to arguments of claim 17 as stated above. Applicant further states that "*Wang does not teach this element (transmitting in accordance with an instruction from the server a request for a document to be attached to the form*" (page 11, third paragraph). Applicant is directed to the rejection of claims 1 and 12 as restated above, and is further directed to rejections of claim 17 as restated above and response to arguments of claim 17 as stated above.
34. **Regarding claims 2, 18 and 22**, the applicant states "*Schmid et al. does not provide the element missing from the independent claims as described above*" (page 11, fourth paragraph). Applicant is directed to the rejection of claims 2, 18 and 22 as restated above. Applicant further states: "*Schmid does not say how the cover sheet is generated*" (page 11, fourth paragraph). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., how the cover sheet is generated) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

35. **Regarding claims 5 and 21**, the applicant states "*Mowry does not provide the elements described above As missing from the corresponding parent claims*" (page 12, first paragraph). Applicant is directed to the rejection of claims 5 and 21 as restated above and is further directed to rejections of claim 17 as restated above and response to arguments of claim 17 as stated above.
36. **Regarding claims 11 and 14**, the applicant states: "*MacPhail does not teach that "documents are transmitted at different times to the institution and the identifying information is used to match the document with the application"* (page 11, second paragraph). Applicant is directed to the rejection of claims 11 and 14 as restated above.

Conclusion

37. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

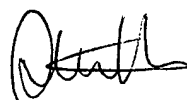
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38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (703) 305-4672. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached at (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
February 23, 2004


STEPHEN S. HONG
PRIMARY EXAMINER